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GROUP 1800

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PATENT  
1199-1-001CIP

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS : MOSES RODRIGUEZ EXAMINER: P. DUFFY #7

SERIAL NO. : 08/692,084 ART UNIT: 1818

FILED : AUGUST 8, 1996

FOR : PROMOTION OF CENTRAL NERVOUS SYSTEM  
REMYELINATION USING MONOCLONAL AUTOANTIBODIES

CERTIFICATE OF MAILING UNDER 37 CFR 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to the ASSISTANT COMMISSIONER FOR PATENTS, WASHINGTON, DC 20231 on June 17, 1997  
Barbara L. Renda, Reg. No. 27626 Dyan R. Melucci 6/17/97  
(Name of Registered Representative) (Signature and Date)

RESPONSE TO REQUIREMENT FOR RESTRICTION  
UNDER 35 U.S.C. § 121

ASSISTANT COMMISSIONER FOR PATENTS  
WASHINGTON, D.C. 20231

Dear Sir:

Responsive to the Office Action in the above-identified Application mailed May 29, 1997, due for response June 29, 1997, and in accordance with Rule 115 of the Rules of Practice, please consider the following remarks.

REMARKS

By this Office Action, the Examiner has required restriction to one of the following inventions under 35 U.S.C. § 121:

I. Claims 1-4, 9-14 and 19, drawn to methods of treating demyelinating diseases and promoting remyelination and therapeutic compositions therefor, classified in Class 242, subclass 141.1; and

II. Claims 5-8 and 15-18, drawn to methods of stimulating the proliferation of glial cells, classified in Class 435, subclass 375.

The Examiner notes that "the inventions of Group I and Group II are related as methods...distinct each from the other because they have different goals as evidenced by the preamble, require different method steps and have different final outcomes (*i.e.*, treatment of disease versus glial cell proliferation and glial cell transplantation" and "a search of proliferation would not encompass myelination."

Responsive to the Requirement for Restriction, Applicant provisionally elects to prosecute the invention of Group I, with traverse. Claims 1-4, 9-14 and 19, drawn to methods of treating demyelinating diseases and promoting remyelination and therapeutic compositions therefor, are encompassed by this election.

Applicant respectfully requests reconsideration of the Requirement for Restriction, or in the alternative, modification of the Restriction Requirement to allow prosecution of more than one group of Claims designated by the Examiner in the present Application, for the reasons provided as follows.

Under 35 U.S.C. § 121 "two or more independent and distinct inventions ... in one Application may ... be restricted to one of the inventions." Inventions are "independent" if "there is no disclosed relationship between the two or more subjects disclosed" (MPEP 802.01). The term "'distinct'" means that "two or more subjects as disclosed are related ... but are capable of separate manufacture, use or sale as claimed, AND ARE PATENTABLE OVER EACH OTHER" (MPEP 802.01) (emphasis in

original). However, even with patentably distinct inventions, restriction is not required unless one of the following reasons appear (MPEP 808.02):

1. Separate classification
2. Separate status in the art; or
3. Different field of search.

Further, under Patent Office Examining Procedures, "[i]f the Search and Examination of an entire Application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions" (MPEP 803, Rev. 8, May 1988) (emphasis added).

Applicant respectfully submits that the groups designated by the Examiner fail to define compositions and methods for using such products, with properties so distinct as to warrant separate Examination and Search. The present claims represent various methods of using monoclonal autoantibodies, and compositions containing these antibodies that merit examination in a single Application. Accordingly, each of the claim groups relates to the use of the particular monoclonal autoantibodies so that a preponderantly coextensive Search would result for each group of claims. For instance, any search for the various methods, or compositions would include a search of the classes wherein the monoclonal autoantibodies themselves would be found. Thus, Applicant submits that the Search and Examination of the entire Application can be made without serious burden, and therefore the Examiner must examine all of the claims of the Application on the merits.

The Examiner's assertions to the contrary notwithstanding, Applicant respectfully submits that conjoint examination and inclusion of all of the Claims of the present Application would not present an undue burden on the Examiner, and accordingly,

withdrawal of the Requirement for Restriction is believed to be in order.

In view of the above, withdrawal of the Requirement for the Restriction is requested, and an early action on the merits of Claims 1-19, is courteously solicited.

Respectfully submitted,



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June 17, 1997